

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

In the Final Office Action, the Examiner again objects to the specification alleging that the incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication, is improper, and that the Applicant is required to amend the disclosure to include the material incorporated by reference.

In the response to the previous Office Action, Applicants responded by stating that the essential material of the priority document is already contained in the specification. However, the Examiner requests that since the essential material is already recited in the application, that Applicant delete the language in the specification allegedly improperly incorporating material from the foreign application.

However, Applicants know of no authority for such a requirement and the Examiner fails to cite any authority that material cannot be incorporated from a foreign application on which an application claims priority. Therefore, Applicants respectfully request that the Examiner provide authority for his position in the response to the Final Office Action.

In the Final Office Action, the Examiner rejects Claims 1-3 and 8-15. Claims 1-3, 8-12 and 14-15 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 5,759,490 to Malchesky (hereinafter "Malchesky") in view of U.S. Patent No. 6,361,751 to Hight, III (hereinafter "Hight"). Claims 1-3, 8-12 and 14-15 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 5,534,221 to Hillebrenner et al. (hereinafter "Hillebrenner") in view of Hight. Claim 13 is rejected under

35 U.S.C. §103(a) as being allegedly unpatentable over Hillebrenner and Hight, and further in view of U.S. Patent No. 3,633,758 to Morse et al. (hereinafter "Morse").

In response, claims 1, 9, 10, 11 and 15 have been amended to clarify their distinguishing features.

The Amendments to claims 1, 9, 10, 11, and 15 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the amendment to claims 1, 9, 10, 11, and 15.

As well as other language, the claims have been amended to recite that "the insertion member has an observation window at the distal end thereof", (or similar language thereto). Such an amendment has been made to clarify that the bend at the distal end where the observation window is provided is restricted, and that bending of portions proximal to such distal end is also restricted.

None of the references cited by the Examiner disclose the insertion member of the endoscope being stowed in the state of being bent and the bend of the insertion member at the distal end side being restricted as recited in the endoscope container claims of the present application.

Furthermore, specifically with regard to claim 1, neither Malchesky, Hillebrenner, Hight, nor Morse disclose or suggest that a positioning member formed in at least one of the tray and the lid member "for positioning an insertion member of an endoscope in order to stow the insertion member in the container in a state of having the insertion member bent in a predetermined form" (underlined portions added by present amendment). Furthermore, neither Malchesky, Hillebrenner, Hight, nor Morse, disclose or suggest the "the positioning member restricting bending of a predetermined portion of the insertion member so

that a bend radius of a bending portion formed at the predetermined portion of the insertion member of the endoscope having a distal end provided with an observation window will be larger than a bend radius of other portions of the insertion member" (underlined portions added by present amendment). Finally, neither Malchesky, Hillebrenner, Hight, nor Morse, disclose or suggest the "positioning member corresponding with the predetermined portion of the insertion member restricts bending of at least a distal 70 cm portion of the insertion member."

Although each of these features is not shown or suggested in the cited references, in particular, they do not at all disclose stowing the insertion member in the container in the state of being bent, and restricting a bend radius at the distal end side of the insertion member.

Thus, Applicants respectfully submit that claim 1 is not rendered obvious by the combination of the cited references.

Specifically, with regard to claim 9, neither Malchesky, Hillebrenner, Hight, nor Morse disclose or suggest "a pipe portion, which sheathes a predetermined portion at the distal end side of the insertion member of an endoscope having the distal end provided with the observation window and holds the predetermined portion in a predetermined form" (underlined portions added by present amendment). Furthermore, neither Malchesky, Hillebrenner, Hight, nor Morse disclose or suggest "a coil pipe portion that is flexible and sheathes a portion of a flexible portion of the insertion member, the flexible tube portion being proximal from the pipe portion of the insertion member."

Thus, Applicants respectfully submit that claim 9 is not rendered obvious by the combination of the cited references.

Specifically, with regard to claim 10, neither Malchesky, Hillebrenner, Hight, nor Morse disclose or suggest "a positioning member for restricting bending of at least a predetermined portion at a distal end of the insertion member of the endoscope having an observation window provided at the distal end so that a bend radius of the predetermined portion of the insertion member will be larger than the minimum bend radius of other portions of the insertion member" (underlined portions added by present amendment). Furthermore, neither Malchesky, Hillebrenner, Hight, nor Morse disclose or suggest, the "positioning member corresponding with the predetermined portion of the insertion member restricts bending of at least a distal 70 cm portion of the insertion member."

As discussed above, although each of these features is not shown or suggested in the cited references, in particular, they do not at all disclose stowing the insertion member in the container in the state of being bent, and restricting a bend radius at the distal end side of the insertion member.

Thus, Applicants respectfully submit that claim 10 is not rendered obvious by the combination of the cited references.

Specifically, with regard to claim 11, neither Malchesky, Hillebrenner, Hight, nor Morse disclose or suggest a positioning member formed in a tray provided with a plurality of pores through which high-pressure steam is led for positioning the endoscope to be stowed in the tray "at least in the state of having the insertion member in part bent" where "the positioning member effecting the positioning to ensure that a predetermined distal portion of the insertion member is stowed in a substantially straight form or in a curved form that exhibits a bend radius larger than the minimum bend radius of a bent portion at the proximal

end side proximal from the predetermined portion of the insertion member" (underlined portions added by present amendment).

Again, although each of these features is not shown or suggested in the cited references, in particular, they do not at all disclose stowing the insertion member in the container in the state of being bent, and restricting a bend radius at the distal end side of the insertion member.

Thus, Applicants respectfully submit that claim 11 is not rendered obvious by the combination of the cited references.

Specifically, with regard to claim 15, neither Malchesky, Hillebrenner, Hight, nor Morse disclose or suggest "a tray ... for stowing an endoscope having an observation window provided at a distal end of an insertion member thereof which is inserted in a subject" (underlined portions added by present amendment). Furthermore, neither Malchesky, Hillebrenner, Hight, nor Morse disclose or suggest "a lid member that blocks the opening of the tray" Lastly, neither Malchesky, Hillebrenner, Hight, nor Morse disclose or suggest "a positioning member formed in at least one of the tray and the lid member for positioning the endoscope in the tray at least in the state of having the insertion member in part bent, the positioning member effecting the positioning to ensure that a predetermined distal portion of the insertion member is stowed in a substantially straight form or in a curved form that exhibits a bend radius larger than a minimum bend radius of a bent portion at an end side proximal from the predetermined portion of the insertion member" (underlined portions added by present amendment).

Again, although each of these features is not shown or suggested in the cited references, in particular, they do not at all disclose stowing the insertion member in the

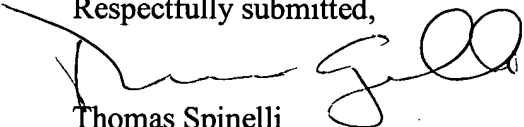
container in the state of being bent, and restricting a bend radius at the distal end side of the insertion member.

Thus, Applicants respectfully submit that claim 15 is not rendered obvious by the combination of the cited references.

Independent claims 1, 9, 10, 11, and 15, as amended, are not rendered obvious by the cited references because neither the Malchesky patent nor the Hillebrenner patent, nor the Hight patent, nor the Morse patent whether taken alone or in combination, teach or suggest an endoscope container or insertion member sheathing member having the features discussed above and recited in independent claims 1, 9, 10, 11, and 15. Accordingly, claims 1, 9, 10, 11, and 15, as amended, patentably distinguish over the prior art and are allowable. Claims 2, 8 and 12-14, being dependent upon claims 1 and 11, are thus allowable therewith.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

  
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